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EXAMINER

DI LORENZO, ANTHONY

ART UNIT PAPER NUMBER

2131

DATE MAILED: 12/31/2001

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/294,956

Applicant(s)

COX ET AL.

Examiner

Anthony DiLorenzo

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 112, 113, 115-119, 121, 124-126 and 128 is/are rejected.
- 7) ☒ Claim(s) 114 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continuation of Disposition of Claims:

Claims pending in the application are 1-3, 5-16, 18-22, 24, 27-41, 47-49, 51-62, 64, 66-68, 70, 73-87 and 108-134.

Claims allowed in the application are 1-3, 5-16, 18-24, 33-41, 47-49, 51-62, 64, 66-68, 70, 79-87, 108-111, 120, 122, 123, 127, and 129-134

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DETAILED ACTION

This Office Action is written in response to the amendment and remarks filed on 9/20/01 in the United States Patent and Trademark Office regarding utility patent application serial no. 09/294,956.

The appropriate sections of Title 35 of the U.S. Code not appearing in this communication have been cited in a previous office action.

Amendments

• Claims

The claim amendments requested by Applicant have been entered as Amendment B. Claims 23, 25, 26, 65, 69, 71, and 72 have been cancelled.

Objections

• Claims

The objection to claims 23 and 69 under 37 CFR 1.75 and 35 USC 112[4] are now moot in view of the withdrawal of those claims from consideration.

Claim Rejections

Claim rejections are detailed according to each applicable section of Title 35 of the U. S. Code and to each claim below. Rejections of dependent claims necessarily incorporate the rejections of the base claim and any intervening claims. Information contained in rejections of non-related claims may also be incorporated by explicit reference to them. Similar claims are grouped together.

• Under 35 USC § 102

• • Maintained

Claims 117 and 124 are rejected under 35 U.S.C. 102(b) as being anticipated by Barton ('997). The grounds of rejection are maintained as they were presented in the Office action dated 6/18/01.

• Under 35 USC § 103

• • Withdrawn

The rejection of claims 1, 3, 5, 6-16, 18-24, 33, 47, 49, 51, 52, 53-55, 56, 57, 58-62, 64, 66-68, 70, 79, 120, 127, and 130-133 under 35 U.S.C. 103(a) as being unpatentable over Barton ('997) in view of Arnold ('172) is withdrawn.

The rejection of claims 2, 34-37, 48, and 80-83 under 35 U.S.C. 103(a) as being unpatentable over Barton ('997) in view of Arnold ('172), as applied above, and further in view of Schneier is withdrawn.

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The rejection of claims 38-41, 84-87, 108-111, 114, 122, 123, 129, and 134 under 35 U.S.C. 103(a) as being unpatentable over Barton in view of Arnold, as applied above, and further in view of Bramall ('101) is withdrawn.

5 • • **Maintained**

Claims 118, 119, 125, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton ('997) in view of Arnold ('172). The grounds of rejection are maintained as they were presented in the Office action dated 6/18/01.

- 10 Claims 121 and 128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton ('997) in view of Arnold ('172), as applied above, and further in view of Schneier. The grounds of rejection are maintained as they were presented in the Office action dated 6/18/01.

- 15 Claims 112, 113, 115, and 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton in view of Arnold, as applied above, and further in view of Bramall ('101)

Allowable Subject Matter

- 20 Claims 1-3, 5-16, 18-24, 33-41, 47-49, 51-62, 64, 66-68, 70, 79-87, 120, 127 and 130-133 are allowed. Independent claims 1, 47, 120, and 127 contain the feature of retrieving data to be inserted into a watermark from an external source such as Global Positioning Satellite, radio transmission, or Internet connection. There is no objective evidence in the prior art that this feature would be obvious to include in the closest prior art watermarking system of Barton.

- 25 Claims 108-111, 122, 123, 129, and 134 are allowed. Claim 114 is objected to for being dependent on a rejected base claim. Independent claims 108, 122, 129, and 134 and dependent claim 114 contain the feature of recognizing a user of a device whose identifier is stored in memory through biometric characteristic recognition.

Response to Remarks

- 30 The rejection of claims 112, 113, 115, and 116 under 35 U.S.C. 103(a) as being unpatentable over Barton in view of Arnold and Bramall was maintained because the traversal of those rejections was based on the use of biometric characteristic recognition in the independent claim. However, claim 112 does not contain this feature.

- 35 Generally, the traverses were persuasive, as indicated by the above allowed claims. With regards to all other rejections that were maintained, this was done because no traverse was presented to those rejections. However, because the maintained rejections are unchanged from the previous Office action, the present Office action is final. It is assumed that Applicant would, in response to this final Office action, either cancel those finally rejected claims or amend them in a manner similar to the allowed claims in order to expedite issuance of a patent.
- 40

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to

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expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony DiLorenzo, whose telephone number is (703) 306-5617. If the examiner is not available, a voice mail greeting will indicate when the examiner will return to the office. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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December 22, 2001

AD
12/22/01

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PRIMARY EXAMINER
ART UNIT ~~222~~ 2132